

REMARKS/ARGUMENTS

Claims 1-28 are pending in this Application.

Claims 1, 10, and 24 have been amended. Claims 1-28 remain pending in the Application after entry of this Amendment. No new matter has been entered.

In the Office Action, claims 1-7, 10-12 and 15-27 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0111911 to Kennedy et al. (hereinafter “Kennedy”). Claims 8, 9, 13, 14 and 28 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Kennedy, in view of U.S. Patent No. 6,250,481 to Heddaya et al. (hereinafter “Heddaya”).

Claim Rejections Under 35 U.S. C. § 103(a)

Applicants respectfully traverse the rejections and request reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) based on Kennedy. The Office Action alleges that the combination of references teach or disclose all of the claimed limitations of the corresponding claims and that one having ordinary skill in that art at the time of the invention would have been motivated to incorporate the teachings of Kennedy, with the ordinary skill of one in the art and the teachings of Heddaya.

Applicants respectfully submit that a prima facie case of obviousness has not been established by the evidence presented in the Office Action. In order to establish a prima facie showing of obviousness, three requirements must be satisfied: all limitations of a pending claim must be expressly or impliedly disclosed by prior art references; there must be a suggestion or motivation in the art for the ordinarily skilled artisan to combine the limitations; and there must be a reasonable expectation of success in making such a combination. (M.P.E.P. § 2143).

In light of the above-recited requirements, Applicants respectfully submit that Kennedy, either individually or, in combination with the ordinary skill of one in the art and/or the teachings of Heddaya, fails to teach or suggest at least one of the claimed limitations recited in each of the corresponding claims.

Claim 1

Amended claim 1 recites a method for distributing documents. As recited in claim 1, a first identifier adapted for association with a first document is produced. The first identifier recited in claim 1 includes first information indicative of a first server configured to create the first document in an original document format. As recited in claim 1, the first identifier is transmitted from the first server to a client based upon at least a request from the client to create the first document on the first server in the original document format. As recited in claim 1, the client associates the first identifier with the first document. As recited in claim 1, a copy of the first document in the original document format is transmitted from the client to the first server. As recited in claim 1, a commit request is transmitted to the first server. As further recited in claim 1, in response to the commit request, the first server becomes responsive to download requests from one or more distribution servers for one or more copies of the first document. The download requests in claim 1 contain the first information.

In various embodiments, documents are provided with an identifier, which includes information indicative of the server system on which a document was created (the origin server). (Application: Page 2, paragraph [08]). The identifier indicating the origin server is transmitted to a client based on a request to create the document in an original document format on the origin server. The client associates the identifier with the document. A copy of the document in the original document format is transmitted to the origin server. A commit request is then transmitted to the origin server. The origin server becomes response to download requests from distribution servers for copies of the document in response to the commit request. The download requests, as recited above, include the first information indicating the origin server of the document.

Applicants respectfully submit that Kennedy fails to teach or suggest at least one of the above recited claim limitations. In particular, Applicants respectfully submit that Kennedy does not teach or suggest the feature of “producing a first identifier adapted for association with a first document, the first identifier including first information indicative of a first server configured to create the first document in an original document format” as recited in claim 1.

The Examiner alleges that the distribution list of Kennedy inherently includes some sort of source identifier, such as a URL/URI or other header identifier that shows the source of the distribution list of Kennedy. However, Applicants respectfully submit that “some sort of source identifier” as allegedly inherently found in Kennedy does not teach or suggest the feature of “producing a first identifier adapted for association with a first document, the first identifier including first information indicative of a first server configured to create the first document in an original document format” as recited in claim 1.

Applicants respectfully note that the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). To establish inherency, the extrinsic evidence “must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill” (emphasis added). Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient (emphasis added). *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

Applicants respectfully submit that the disclosure of Kennedy does not inherently teach or suggest any sort of identifier, such as the URL/URI or other header identifier as alleged by the Examiner, that is required to be adapted for association with a document as in claim 1. In Kennedy, for the context of communications networks pointed to by the Examiner, the source identifier is more likely to be understood from the disclosure of Kennedy to be part of a communications signal, datagram, or packet indicating the source of that packet. Persons of ordinary skill would more readily recognize the header identifier as associated with a source/destination of the packet, or other features of a cell/datagram. A header identifier in Kennedy is substantially different from an identifier adapted for association with a document as recited in claim 1. Kennedy simply fails explicitly or inherently to provide any teaching or

suggestion in the disclose that would make clear to persons of ordinary skill that the “some sort of identifier” showing the source of the distribution list in Kennedy necessarily discloses that the same identifier is adapted for associated with a document as required in claim 1.

Moreover an identifier, as recited in claim 1, includes information indicative of a first server configured to create the first document in an original document format. In contrast to claim 1, the URL/URI or other header identifier of Kennedy merely shows the source of the distribution list. The extrinsic evidence of Kennedy simply fails to “make clear” to persons of ordinary skill in the art, allowing them to reasonably recognize the source of the distribution list as indicative of an origin server for creating the document in an original document format as required in claim 1.

Furthermore, in Kennedy, to publish a document, a user selects the document distribution system as a printer or other software application as the “Name” of the printer. (Kennedy: Col. 3, paragraph [0033]). However, this “Name” is associated with the document distribution system or a computer program that facilitates distribution. Applicants respectfully submit that providing the name of a printer associated with a computer program does not teach or suggest producing a first identifier adapted for association with a first document. Accordingly, Kennedy further does not explicitly or inherently teach or suggest that the identifier adapted for association with the document includes information indicative of a server configured to create the first document in an original document format as recited in claim 1.

Applicants also respectfully submit that Kennedy fails to teach or suggest the feature of “associating by the client the first identifier with the first document” as recited in claim 1. The Examiner points out that the URL/URI or other header identifier shows the source of the distribution list. However, persons of ordinary skill would not readily recognize the source of the distribution list as necessarily disclosing an association by the client as required in claim 1. Moreover, paragraphs [0035], [0043], [0055], and [0060] pointed to by the Examiner do not teach or suggest any such association between a document and an identifier as recited in claim 1.

Applicants respectfully submit that Kennedy further fails to teach or suggest the feature of “in response to the commit request, the first server becoming responsive to download

requests from one or more distribution servers for one or more copies of the first document, the download requests containing the first information” as recited in claim 1. Instead, Kennedy discloses a document distribution system controller (hereinafter DDSC) (FIG. 1, element 26) that routes or distributes a document to one or more document distribution providers. Kennedy discloses that the DDSC publishes, prints, and e-mails the document, in other words, the DDSC “pushes” the distribution of the document. (Kennedy: FIG. 3). Paragraph [0045] of Kennedy discloses that the DDSC routes the document to the services based on the user’s input in response to the distribution options list. Kennedy clearly discloses that the DDSC sends the document and any instructions to a service provider in response to user instructions. (Kennedy: Paragraph [0060]). The document distribution in Kennedy in response to the distribution list from the user is substantially different from receiving download requests from one or more distribution servers for one or more copies of the first document, the download requests containing the first information as recited in claim 1.

In light of the above, Applicants respectfully submit that Kennedy fails to teach or suggest each and every limitation of claim 1. Accordingly, Applicants submit that claim 1 is allowable over the cited references.

Claims 2-26

Applicants respectfully submit that independent claims 10, 15, and 24 are allowable for at least a similar rationale as discussed above for the allowability of claim 1, and others.

In particular, the Office Action rejected claim 15 with the same rationale as claim 1. The Office Action further focused the rejection on the feature of “at each of the first servers, associating a second identifier with the first document, the second identifier including the first information” as recited in claim 15. However, Kennedy does not teach or suggest a first document having associated therewith a first identifier, the first identifier including first information indicative of an originating server as recited in claim 15. The first information as

recited in claim 15 is indicative of an originating server. As discussed above, the originating server is the server system on which the document was created (the origin server).

Furthermore, claim 15 includes the features of “receiving a second document at at least one of the first servers, the second document being a second version of the first document,” “retaining the first document and the second document on the at least one of the first servers,” and “distributing the second document to a second plurality of servers” which are not required in claim 1. Applicants respectfully submit that Kennedy fails to teach or suggest at least the above features as recited in claim 15, which have not been addressed by the Examiner.

Applicants further submit that, even if Kennedy were combined with Heddya, the result would not result in claims 1, 10, 15, and 24 or otherwise make claims 1, 10, 15, and 24 obvious. For example, neither Kennedy or Heddya or the combination teach or suggest the features of “transmitting the first identifier from the first server to a client based upon at least a request from the client to create the first document on the first server in an the original document format” and “associating by the client the first identifier with the first document” as recited in claim 1.

Applicants submit that dependent claims 2-9, 11-14, 16-23, and 25-26 that depend directly and/or indirectly from the independent claims 1, 10, 15, and 24 respectively, are also allowable for at least a similar rationale as discussed above for the allowability of the independent claims. Applicants further submit that the dependent claims recite additional features that make the dependent claims allowable for additional reasons.

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PATENT

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,

/Sean F. Parmenter/
Sean F. Parmenter
Reg. No. 53,437

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 650-326-2400
Fax: 650-326-2422
SFP:am
60844520 v1